

## **REMARKS**

Claims 24, 26, 27, 29-34 and 36-47 are pending in this application. The Examiner objected to claims 24, 26, 32, 33, 35 and 41 due to informalities. The Examiner rejected claim 28 under 35 U.S.C. § 112, second paragraph. The Examiner also rejected claims 24-26, 29-31, 34-40, 42-46 as being anticipated under 35 U.S.C. § 102(e) and rejected claims 27, 32, 33 and 41 as being unpatentable under 35 U.S.C. § 103. Claims 25, 28 and 35 are cancelled. New claim 47 has been added. The foregoing amendments and the following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections. An early Notice of Allowance is therefore requested.

The Examiner objected to claims 24, 26, 32, 33, 35 and 41 due to certain informalities and suggested amendments to be made. Claim 35 was cancelled. With the exception of claim 35, all suggested amendments were made to above referenced claims. The Examiner's objection is respectfully traversed.

The Examiner rejected claim 28 under 35 U.S.C. § 112, second paragraph. Claim 28 has been cancelled.

The Examiner rejected claims 24-26, 29-31, 34-40, 42-46 as being anticipated under 35 U.S.C. § 102(e) by Silberberg et al. (US Patent No. 6,327,068). The Examiner contends that Silberberg describes a dispersive element for spatially separating the spectral components of the laser radiation, means for manipulating individual spectral components, and another dispersive element for spatially superimposing the manipulated individual spectral components. The Examiner further contends (with regard to claim 35) that Silberberg teaches that the manipulator means is purposefully optimized by feeding back a measurement signal and the desired measurement signal is therefore adjusted.

Silberberg, however, does not disclose the use of the coupling device with a laser scanning microscope that is examining a sample. Thus, when Silberberg describes the use of

feedback it does not describe using a feedback signal coming from the sample. In col. 9, lines 40-43, Silberberg describes using a sample of the final output pulse as the feedback signal 48 to adjust the input pulse to the amplifier chain. That final output pulse comes directly from the amplifiers.

Claim 24 has been amended to include, *inter alia*, the limitation that was previously contained in claim 35, namely that "the manipulator means is purposefully optimized by feeding back a measurement signal and the desired measurement signal is therefore adjusted." Thus, Silberberg cannot anticipate amended claim 24 since it does not disclose using the measurement signal as a feedback signal. Thus, the Examiner's rejection of claim 24 under 35 U.S.C. § 102(e) is traversed and is allowable.

Newly added independent claim 47 also recites the limitation that "the manipulator means is purposefully optimized by feeding back a measurement signal and the desired measurement signal is therefore adjusted." As such, claim 47 is also not anticipated by Silberberg and is allowable.

Claims 26, 27, 29-34 and 36-46 all either depend from amended claim 24 or from new claim 47. As such, these claims are not anticipated by Silberberg for the same reasons that claims 24 and 47 are not anticipated. These claims are also allowable.

The Examiner also rejected claims 27, 32, 33 and 41 as being unpatentable under 35 U.S.C. § 103 in view of the combination of Silberberg and Simon (US Patent No. 5,995,281). This combination, however, does not render either amended claim 24 nor newly added claim 47 obvious because of the same reason that Silberberg did not anticipate these claims. As stated by the Examiner in the Office Action, Simon does not teach the inclusion of a means for manipulating individual spectral components within the apparatus. Consequently, Simon cannot teach a feedback system that utilizes the measurement signal as the feedback signal. Therefore, amended claim 24 and newly added claim 47 are not rendered obvious by the combination of Silberberg and Simon and are allowable.

Claims 26, 27, 29-34 and 36-46 all either depend from amended claim 24 or from new claim 47. As such, these claims are not rendered obvious by the combination of Simon and Silberberg for the same reasons that claims 24 and 47 are not rendered obvious. These claims are also allowable.

Claims 24, 26, 27, 29-34 and 36-47, the only claims pending in the application, are believed by applicants to define patentable subject matter and should be passed to issue at the earliest possible time. An early Notice of Allowance is requested. Please call the undersigned for any reason to expedite prosecution of this application.

Respectfully submitted,

  
Stephen M. Chin, Reg. No. 39,938

GHK/SMC:dw  
Reed Smith LLP, 29<sup>th</sup> Floor  
599 Lexington Avenue  
New York, NY 10022-7650